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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,213	02/13/2002	Takeshi Nagashima	46275	4799

20736 7590 07/17/2006

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,213

Applicant(s)

NAGASHIMA ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-16 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 and 18-33 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11 and 13 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/1/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response 05/01/2006 has been fully considered. Claims 12 and 17 are canceled, and claims 1-11, 13-16 and 18-33 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 6,096,469) in view of Ohbayashi et al. (US 6,436,515 B1).
4. Anderson discloses an ink jet receptor media having a substrate and an ink receptor media on the substrate (abstract). The substrate is a polyester polymeric film (col. 10, line 38). The ink receptor media comprises particles (col. 4, line 39) and hydrophilic binder such as polyvinyl alcohol (col. 9, line 25). For applications in which transparency is desired, the particles have a mean particle size of about 10 to less than 50 nm (col. 6, line 66). The particles are silica prepared by wet process and comprise silane group (col. 7, lines 6-49). The ink receptor media may be coated on both sides of the substrate (col. 11, line 6), and the ink receptor media coated on the backside of the substrate is equivalent to the claimed back-coating layer. With respect to void ratio value it is elementary that the mere recitation of newly discovered function or property,

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inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229.

Since the Anderson reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

5. Anderson further teaches that the ink receptor media comprises cationic polymers that are pigment particles (col. 9, lines 62-65). However, Anderson fails to disclose the particle size of the cationic polymer particles. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the particle size in order to optimize the ink fixing property of the layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

6. Anderson does not expressly disclose the solid content of the ink receptor media applied on either side of the substrate. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the solid content of the receptor media applied on either side of the substrate in order to optimize curling and

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ink-absorbing properties of the layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

7. Anderson does not disclose the opacity of the substrate.

8. Ohbayashi teaches an ink jet recording sheet comprising a support and an ink absorptive layer on the support (abstract). The support comprises a polyethylene laminated paper having a translucency of at least 80% (col. 4, line 65) measured employing a method specified in JIS-P-8138.

9. Anderson and Ohbayashi are analogous art because they are from the same field of endeavor that is the ink jet recording material art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the substrate of Ohbayashi with the invention of Anderson in order to provide a recording material having a water non-absorptive support which does not result in wrinkling (col. 2, line 62 and col. 3, line 11).

10. With respect to claim 13, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to obtain a blue film by adding a blue color while the film is being processed. Changing a color of a film by adding a color pigment is notoriously known in the art.

Response to Arguments

11. Applicant's argument is based on that the translucency is "a degree of opacity"; therefore Ohbayashi teaches opacity of 80% or more. This argument is not persuasive

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for the following reason. Translucent or translucency is defined as ---permitting the passage of light---. On the other hand, opaque or opacity is defined as ---blocking the passage of light---. **See Merriam-Webster OnLine.** Thus translucency is the opposite of opacity, and the Examiner interprets the translucency value of 80% or more of Ohbayashi as the opacity value of less than 80%. Therefore, claims 1-3, 7-11 and 13 stand rejected.

Allowable Subject Matter

12. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 14-16 and 18-33 are allowed.

14. The combination of Anderson and Ishii neither teach nor suggest having two ink receptor media of outermost ink receptor media and innermost ink receptor media, wherein the outermost media comprising alumina or alumina hydrate having the claimed particle size and the innermost media comprising fumed silica having the claimed particle size.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.
July 6, 2006.


BETELHEM SHEWAREGED
PRIMARY EXAMINER